

Appl. No. 10/678,206
Atty. Docket No. 9049
Amdt. dated 04-Oct-2006
Reply to Office Action of July 5, 2006
Customer No. 27752

REMARKS

Amendments to the Claims

Claims 1 and 4-16 are pending in the present application. Claims 2-3 have been currently canceled. New claims 4-16 have been currently added. No additional claims fee is believed to be due.

Claim 1 has been amended as shown above. Support for this amendment can be found in the original claim 1, in the specification at page 3, lines 18-20 and page 6, lines 3-4, as well as in Figures 1-8.

Support for new claim 4 can be found in the specification at page 3, lines 27-28 and 31-32 and at page 4, lines 14-25.

Support for new claim 5 can be found in the specification at page 3, lines 18-20.

Support for new claims 6-7 can be found in the specification at page 6, lines 3-4.

Support for new claims 8-10 can be found in the specification at page 4, lines 1-12.

Support for new claim 11 can be found in the specification at page 5, lines 13-15.

Support for new claims 12-13 can be found in the specification at page 5, lines 23-28 as well as in Figure 3.

Support for new claim 14 can be found in the specification at page 3, lines 2-26 as well as in Figure 3.

Support for new claim 15 can be found in original claim 3 and in the specification at page 3, lines 18-20 and 27-32; at page 4, lines 114-25; at page 6, lines 3-4; as well as in Figures 1-8.

Support for new claim 16 can be found in original claim 1 and in the specification at page 3, lines 18-20 and 27-32; at page 5, lines 1-2; and at page 6, lines 3-4.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC 112, First Paragraph

Claims 1-3 are rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventors, at the time the application was filed, had possession of the claimed invention. More particularly, the claims 1-3 contained

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the limitation that the handle was "rigid", and the Examiner asserts that the original disclosure does not disclose the handle to be rigid and that one of ordinary skill in the art could not recognize through the drawings that the handle was made of a rigid material. Applicants respectfully traverse the present rejection based on the following comments.

Applicants have amended claim one as shown above to delete the limitation of the handle being "rigid" and have also canceled claims 2-3. Thus, it is believed that the present rejection has been obviated.

In claim 1, Applicants now recite that the handle is "molded from one or more plastic materials in an elongated form". There is clear support for this amendment in the original disclosure of the specification. At page 6, lines 3-4, the specification discloses that the "[a]pplicator 10 can be made from any moldable material, such as, for example, polyethylene or polypropylene." The handle is part of the applicator, and polyethylene or polypropylene are types of moldable plastic materials. Thus, there is support for reciting that the handle is molded from one or more plastic materials. Further, at page 3, line 18, the specification discloses that the "[h]andle 20 is an elongated handle that a user grasps in his or her hand." Thus, there is also support for reciting that the handle is molded in an elongated form.

Accordingly, it is believed that the present rejection has been obviated. Moreover, it is respectfully submitted that there is support in the original disclosure of the specification for the current amendment to claim 1.

Rejections Under 35 USC 103(a) Over U.S. Patent No. 1,161,719 to Norton in view of U.S. Patent No. 5,561,856 to Pesco

Claims 1-3 are rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 1,161,719 to Norton ("Norton") in view of U.S. Patent No. 5,561,856 to Pesco ("Pesco"). The Examiner asserts that Norton discloses a massage glove being defined as a treatment applicator which inherently can be used for applying a hair treatment to the hair. The Examiner further asserts that the massage glove of Norton comprises each claimed element of Applicants claims 1-3, except that Norton does not disclose that the glove body (which the Examiner asserts is representative of a handle) is formed of a rigid material.

The Examiner then asserts that Pesco discloses a glove comprising a rigid insert which is inserted into the palm portion and the thumb portion of the glove to protect the thumb in the event of a fall by a person wearing the glove. Thus, the Examiner concludes

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that it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the rigid insert as taught by Pesco into the massage glove of Norton in order to protect the thumb of the user in case of falling on the hand.

Applicants respectfully traverse the present rejection based on the following comments. The Examiner has failed to establish a *prima facie* case of obviousness based on the combination of Norton and Pesco because there is no suggestion or motivation to combine Norton with Pesco. Alternatively, the combination of Norton and Pesco does not teach or suggest all of Applicants' claim limitations and, therefore, does not establish a *prima facie* case of obviousness.

There is no suggestion or motivation to combine the teachings of Norton with the teachings of Pesco to achieve the modified massage glove of Norton as proposed by the Examiner. Indeed, the modification proposed by the Examiner would render the massage glove of Norton unsatisfactory for its intended purpose. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see also* MPEP 2143.01 at 2100-129 (Rev. 5, Aug. 2006). Consequently, a *prima facie* case of obviousness has not been established.

As acknowledged by the Examiner, Norton discloses a massage glove. Norton discloses that its invention "relates to massage gloves having a receptacle or receptacle adapted to accommodate a substance or substances employed during the massage with the glove." Norton at column 1, lines 9-12. Further, Norton discloses that the object of its invention "is to provide a simple and inexpensive glove having one or more receptacles associated therewith, which receptacles are elastic and which can be easily filled a desired substance and from which the substance can be easily fed and the feed easily controlled by the party wearing the glove." Norton at column 1, lines 13-20. Clearly, the glove of Norton is intended to be worn by a user who is giving a massage to himself or another person. Thus, the glove of Norton is designed to provide a user with ease of hand movement while giving the massage and to allow for easy control of the feed of the substance during the massage.

In contrast, the invention of Pesco is directed to a palmar anterior thumb support for use with a glove or mitten, which could be worn by persons skiing or performing other

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activities which risk falling on the hands. More specifically, Pesco discloses that its thumb support "covers substantially all of the palm of the hand and substantially all of the palmar side of the thumb." Pesco at column 2, lines 47-49. Further, Pesco discloses that "the support is intended to maintain the thumb in a position of safety, i.e., the hand with the thumb positioned parallel to and extending generally below the index finger, in a grasping position. In this position, the thumb opposes and is ready to complete the pinch grip that permits objects (e.g., ski poles), [*sic comma*] to be grasped." Pesco at column 4, lines 3-8. Thus, it is apparent that the incorporation of the thumb support of Pesco in a glove is intended to provide immobilization of the thumb when the glove with the thumb support is worn by a person.

Consequently, to modify the massage glove of Norton by incorporating the thumb support of Pesco would result in the massage glove of Norton being rendered unsatisfactory for its intended purpose. Such a modification would be unsatisfactory because the thumb support of Pesco would immobilize the thumb, maintaining it in a grasping position relative to the other fingers. This configuration would not allow the movement of the hand and fingers which is typical when giving a massage. Therefore, there is no suggestion or motivation to combine Pesco with Norton to achieve the modified massage glove of Norton as proposed by the Examiner.

Moreover, the assertion of the Examiner that one of ordinary skill in the art would be motivated to employ the thumb support of Pesco in the massage glove of Norton in order to protect the thumb of the user in case of falling on the hand does not support a *prima facie* case of obviousness. Namely, no motivation exists because, generally, there is little to no risk that a person who is giving a massage while wearing a massage glove will fall on his or her hand. The level of risk of violently or dangerously falling on the hands by one giving a massage is very different from that associated with one who is, for example, skiing. Thus, the assertion by the Examiner amounts merely to one in which the references *can* be combined or modified but for which there is no suggestion in the prior art of the desirability of the proposed combination.

Alternatively, the combination of Norton and Pesco does not teach or suggest all of Applicants' claim limitations and, therefore, does not establish a *prima facie* case of obviousness. Applicants' claim 1 is directed to a hair treatment applicator for applying a hair treatment to hair. As currently amended, this hair treatment applicator comprises a

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handle having a longitudinal axis and *being molded from one or more plastic materials in an elongated form*; and a plurality of retaining structures connected to the handle, each of the plurality of retaining structures comprising a base and a plurality of tines and being configured for holding the hair treatment; wherein the base faces in a direction substantially parallel to that of each other retaining structure and each of the plurality of tines extends substantially perpendicularly from the base; and wherein each of the retaining structures is separated from each other of the plurality of retaining structures by a separation volume.

In contrast, the disclosures of Norton and Pesco, taken separately or in combination, fail to disclose a hair treatment applicator as currently claimed which has an elongated handle molded from one or more plastic materials. As discussed above, the disclosure of Norton is directed to, and is limited to, a glove intended for use in giving massages. Nothing in the disclosure of Norton teaches or suggests the use of anything other than a "simple and inexpensive" glove to carry out the invention of Norton. The Examiner continues to assert that the claimed term "handle" is simply a matter of terminology and, thus, without any further structural limitations reads on the body of a glove. However, Applicants respectfully submit that the term "handle" itself is understood by one of ordinary skill in the art to be different from the body portion of a glove because a handle is typically grasped by a hand whereas the body of a glove is designed to encase a hand which is inserted therein. Furthermore, the body of the glove of Norton is not a handle being molded from one or more plastic materials in an elongated form, as currently claimed. Thus, Norton fails to disclose a hair treatment applicator comprising a handle which is molded from a plastic material in an elongated form.

Similarly, the disclosure of Pesco is limited to a thumb support which is intended to be used in combination with a glove. The thumb support of Pesco is not a handle being molded from one or more plastic materials in an elongated form, and is not itself intended to be grasped in the hand of a user. Rather, the thumb support is, for example, sewn into the space between fabric layers of a glove so that when the glove is worn the thumb support is maintained in the proper location. Thus, while the thumb support of Pesco can be made from a plastic material, it is not a handle in an elongated form which allows it to be grasped by a hand.

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Therefore, the combination of Norton and Pesco fails to teach or suggest all of Applicants' claim limitations and, therefore, does not establish a *prima facie* case of obviousness.

With respect to new claims 4-14, an argument analogous to that made with respect to claim 1 can be made because claims 4-14 depend directly or indirectly from claim 1.

Likewise, with respect to new independent claims 15 and 16, an argument analogous to that of claim 1 can be made because each claim recites the relevant limitations of claim 1 discussed above.

Consequently, the Examiner has failed to establish a *prima facie* case of obviousness based on the combination of Norton and Pesco. Namely, there is no suggestion or motivation to combine Norton with Pesco, or, alternatively, the combination of Norton and Pesco does not teach or suggest all of Applicants' claim limitations. Therefore, Applicants' claims 1 and 4-16 are novel and unobvious over the combination of Norton and Pesco.

CONCLUSION

In light of the amendments and remarks presented herein, it is requested that the Examiner reconsider and withdraw the present rejections. Early and favorable action in the case is respectfully requested.

Applicant has made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicant respectfully requests reconsideration of this application and allowance of Claims 1 and 4-16.

Respectfully submitted,
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